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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,214	08/11/2000	Heinz Baier	DE9-1999-0050US1 (590.018)	7894
35195	7590	11/05/2004	EXAMINER	
FERENCE & ASSOCIATES 400 BROAD STREET PITTSBURGH, PA 15143			TRAN, DENISE	
			ART UNIT	PAPER NUMBER
			2186	
DATE MAILED: 11/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

.09/637,214

Applicant(s)

BAIER, HEINZ

Examiner

Denise Tran

Art Unit

2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/30/04 has been entered.

2. Claims 1-4 are presented for examination.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because TCK, TDI, TMS, and TDO should have a direction of data flow.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The amendment filed 8/30/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in particular, "...controlling said MUX element in order to be able to read a schema from said FPGA into said EEPROM" claim 2, lines 5-6 introduces new matter into the disclosure of the

invention. According to, fig.1 and specification page 8, lines 7-9, there are four connections TCK, TDI, TMS, and TDO in order to read the configuration data or schema from FPGA into EEPROM. In addition, fig. 1, and specification page 8, lines 1-6, teaches the MUX 14 can be controlled via line MUX CTL in order to read data from PROM 10 when the MUX CTL is inactive or from EEPROM 12 when the line MUX CTL is active; and the data line 27 is an output from MUX 14 to FPGA. Therefore, the original specification fail to support controlling said MUX element in order to be able to read a schema from said FPGA into said EEPROM.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "controlling said MUX element in order to be able to read a schema from said FPGA into said EEPROM" claim 2, lines 5-6 and the MUX being controllable to permit data to be read from said FPGA device, claim 3, lines 9-10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, "... controlling said MUX element in order to be able to read a schema from said FPGA into said EEPROM" claim 2, lines 5-6 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. According to, fig.1 and specification page 8, lines 7-9, there are four connections TCK, TDI, TMS, and TDO in

order to read the configuration data or schema from FPGA into EEPROM. In addition, fig. 1, and specification page 8, lines 1-6, teaches the MUX 14 can be controlled via line MUX CTL in order to read data from PROM 10 when the MUX CTL is inactive or from EEPROM 12 when the line MUX CTL is active; and the data line 27 is an output from MUX 14 to FPGA.

8. Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reading data from FPGA into EEPROM by TCK, TDI, TMS, and TDO, fig.1 and specification page 8, lines 7-9 and the MUX selecting either EEPROM 12 or PROM 10 when the MUX CTL is active or inactive, and the data line 27 is an output from MUX 14 to FPGA fig. 1, fig. 1, specification page 8, lines 1-6, does not reasonably provide enablement for said MUX element being controlled to permit data to be read from said FPGA. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. In particular, the current disclosure does not provide enablement for said MUX being controllable to permit data to be read from said FPGA. Because according to, fig.1 and specification page 8, lines 7-9, there are four connections TCK, TDI, TMS, and TDO in order to read the configuration data or schema from FPGA into EEPROM. In addition, fig. 1, and specification page 8, lines 1-6, teaches the MUX 14 can be controlled via line MUX CTL in order to read data from PROM 10 when the MUX CTL is inactive or from EEPROM

12 when the line MUX CTL is active; and the data line 27 is an output from MUX 14 to FPGA.

9. Claim 2 is objected to because of the following informalities: line 10, "the configuration" should be --a configuration--. Appropriate correction is required.

10. Claims 1-4 are allowable over the prior art of record.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Alfke (US 6260139) shows FPFA control structure for self-reconfiguration.
- b) Aldebert et al. (5794033) shows reprogramming of hardware logics.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise Tran whose telephone number is (571) 272-4189. The examiner can normally be reached on Monday, Thursday, and an alternate Friday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (571) 272-4182. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306 for central Official fax.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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D.T.

October 29, 2004

*Devin Ryan*